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10/085,154	02/27/2002	Binh T. Nguyen	IGT1P079/P-684	1303
22434	7590	05/21/2004	EXAMINER	
BEYER WEAVER & THOMAS LLP			ONEILL, MICHAEL W	
P.O. BOX 778			ART UNIT	
BERKELEY, CA 94704-0778			PAPER NUMBER	

3713

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/085,154

**Applicant(s)**

NGUYEN ET AL.

**Examiner**

Michael O'Neill

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-38 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Wells et al. EP 1,120,757 A2.

Claims 1-38 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 09/491,899 which has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future publication or patenting of

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the copending application. Note that is application is the priority document to the EPO publication EP 1,120,757.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

Claims 33-38 rejected under 35 U.S.C. 102(e) as being clearly anticipated by Weiss, USPN 6,511,377. See figure 10 with is a drawing of a smart card.

Claims 1-4, 6, 7, 8, 11, 12, 14, 15, 17-22, 24-26, 29, 30 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Green, USPN 5,954,583.

Green discloses a secure access control system that contains a system and method for negotiating instruments wherein said instruments have biometric data contained therein. For instance, in the preferred embodiment of Green, the system has a smart card which contains storage means to store identification data, such as a PIN, and image data, the biometric data, of a gaming player. The system is designed to communicate between

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the smart card reader/writer, which as a reader is a scanner, the smart card containing the data and a image capture and analysis means. In general operation, the player inserts the smart card into the player tracking unit and stands in front of a digital camera, the camera takes the player's picture and digitizes it. The system compares the digitized data on the smart card with the captured digitized data. If there is a match, then the player may continue with gaming operations such as playing the game, depositing and withdrawing monies or transferring credits with an account. With respect to certain dependent claims not clearly explained by the reference because they are common features to the art: Re. claims 2, 4, 22, see figures 8 and 2. Re. claim 3, see figure 3. Re. claims 6, 7, 8, 11, 12, 21, 24-26, 29, 30, see figure 1, (12,13) wherein a smart card reader is deemed to be a scanner because it is reading the data off the smart card; a CCD is a digital camera because a digital camera uses a CCD to digitize and project the image onto the LCD of a view finder screen; the reference discloses taking at least two pictures of the player, one in light and the other in dark conditions. This changes the diameters of the pupils thus demonstrating that the is an actual person and not a photo of the person in front of the lens means. Thus, this reads on the limitation of ratiometric data because

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the pupil size will change with the different lighting conditions. Smart cards are consider a cashless voucher and the data contained on them is either encoded (a type of formatting such as MP3) and/or encrypted. The cards are negotiable as well: either the player takes the card to the gaming machine and plays with the amount of credits thereon or the player takes the card to the cashier and receives the amount of money contain on the smart card instrument. For claim 20, see figure 5.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 5, 13, 16, 23 and 31 are rejected under 35 U.S.C.

103(a) as being unpatentable over Green, USPN 5,954,583.

Green lacks clearly disclosing utilization of touchscreen technology. However, touchscreen technology is notoriously well-known in the art. The motivation behind using touchscreen technology on a gaming machine is that it removes the need for the player to move their eyes up and down thus reducing eye fatigue. Also, touchscreen technology reduces the number of mechanical components thus reducing the wear and tear on a gaming machine and thus leading to longer service intervals. Therefore, absent a showing of criticality in using such technology within the instant invention, the utilization of such technology is a matter of design choice left to the inventor's discretion given the equipment available to the inventor. Voice recognition technology has now become ubiquitous in the computer related invention arts. It is utilized particularly in telephonic communications for the person on the phone to instruct the telephone computer where to direct the call. Again, because the Applicant appears to have listed a plethora of biometrics to be used and giving equal weight to them all and Green uses one of the equivalent biometrics listed, absent a showing of

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critically for this particular biometric and the prevalence of voice recognition technology through out the computer arts, one of ordinary skill in the art would see its utilization as a design choice depend upon the inventor discretion and equipment available thereto. Also, Green lacks in disclosing bar code technology on the smart card. However, such technology is well known in the art as it facilitates identification data transfer and therefore absent a showing of criticality in the utilization of such technology within the instant invention would be an obvious design choice to the inventor at the inventor's discretion on what identification data means the inventor's wishes to utilize in order to facilitate identification data transfer.

Claims 9, 10, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green in view of Van Alphen, WO 94/16416.

In an analogous system, Van Alphen teaches and suggest the utilization of "body-dependent characteristics", i.e. biometrics. Such utilization is taught to ensure " that it is impossible to commit fraud with the playing of cards, for example, by giving the card to another. Van Alphen lists three types of biometric data that can be used: blood vessels in the player's hand, eye scan, and finger print. It would have been



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obvious to incorporate any of the above biometrics into Green in order to avoid the commitment of fraud as suggested by Van Alphen.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael O'Neill whose telephone number is 703-308-3484. The examiner can normally be reached on Monday through Friday 8:30 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J. Walberg can be reached on 703-308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**MICHAEL O'NEILL**  
**PRIMARY EXAMINER**